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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/390,303 | 09/03/1999 | ATLE HEDLOY | 9877-0003-20 | 6685 |

24267 7590 09/27/2002

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EXAMINER

MOFIZ, APU M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2175

DATE MAILED: 09/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Am
09-25-02
Office Action Summary

Application No.

09/390,003 09/390-303

Applicant(s)

IRELAND ET AL.

Examiner

Apu M Mofiz

Art Unit

2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on the amendment filed on 08/14/2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1,4-8,16-18,20-22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams, Jr. (U.S. Patent No. 6,108,686 and Williams hereinafter).

As to claims 1,7 and 8, Williams teaches providing a record retrieval program (Abstract; col 3, lines 1-67; col 4, lines 48-67), providing an input device within a window or screen of the operating system (Abstract; col 3, lines 1-67; col 4, lines 48-67) and configured to enter an execute command which initiates a record retrieval from local (i.e. local database) (Abstract; col 3, lines 1-67; col 4, lines 48-67) and remote information sources (i.e. remote database) using the record retrieval program (Abstract; col 3, lines 1-67; col 4, lines 48-67), using said record retrieval program to enter first information (i.e. keyword to be entered in the queries) into search fields (Abstract; col 3,

lines 1-67; col 4, lines 48-67; col 6, lines 1-67) provided in said record retrieval program, entering the execute command using the input device after the step of entering the first information (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67), searching, using the record retrieval program, the local and remote information sources (i.e. local and remote databases) for second information associated with the first information (see Fig.2; Fig.11; Fig.12; col 7, lines 40-46; col 7, lines 65-67; col 8, lines 1-19) (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67) and displaying the second information (i.e. displaying the queried information based on keywords) in said record retrieval program (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67), when one of the local and remote information sources includes second information associated with the first information (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67).

As to claims 4,10,21 and 25, Williams teaches the step of using said record retrieval program comprises using said record retrieval program to enter first information (i.e. keyword in a query) comprising at least one of a name, a title, an address, a telephone number, and an email address, or a part thereof (i.e. analogous to keywords in a query), into said retrieval program (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67) and the step of searching comprises searching, using the record retrieval program (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67), the local and remote information sources for second information comprising at least one of a name, a title, an address, a telephone number, and an email address, associated with the first information (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67).

As to claims 5,11,14,16 and 22, Williams teaches the step of providing an input device comprises providing one of a touch screen, a keyboard button, an icon, a menu and a voice command device (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67), configured to enter an execute command which initiates a record retrieval from local and remote information sources using the record retrieval program (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67), and the step of displaying the second information comprises displaying the second information comprising one of displaying a message screen with the second information and providing a voiced response of the second information (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67).

As to claims 6,12,17 and 18, Williams teaches the step of providing an input device comprising providing an input device configured to enter an execute command which initiates a record retrieval from local and remote information sources comprising at least one of a file (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67), a database (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67), a database program, a computer network, and a contact management program, using the record retrieval program (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3,13-15,20,24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams, Jr. (U.S. Patent No. 6,108,686 and Williams hereinafter) as applied above, in view of Halim et al. (U.S. Patent No. 6,304,881 and Halim hereinafter).

As to claims 3,20,24 and 27, Williams does not teach providing a user the option of making changes to the second information directly in the local information source.

Halim teaches providing a user the option of making changes to the second information directly in the local information source (Abstract; col 2, lines 30-67).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Williams with the teachings of Halim to include providing a user the option of making changes to the second information directly in the local information source with the motivation to update the remote database using the information related to the local update (Halim, Abstract).

As to claim 13, Williams teaches the step of using said record retrieval program comprises using said record retrieval program to enter first information (i.e. keyword in a query) comprising at least one of a name, a title, an address, a telephone number, and an email address, or a part thereof (i.e. analogous to keywords in a query), into said retrieval program (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67) and

the step of searching comprises searching, using the record retrieval program (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67), the local and remote information sources for second information comprising at least one of a name, a title, an address, a telephone number, and an email address, associated with the first information (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67).

As to claim 14, Williams teaches the step of providing an input device comprises providing one of a touch screen, a keyboard button, an icon, a menu and a voice command device (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67), configured to enter an execute command which initiates a record retrieval from local and remote information sources using the record retrieval program (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67), and the step of displaying the second information comprises displaying the second information comprising one of displaying a message screen with the second information and providing a voiced response of the second information (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67).

As to claim 15, Williams teaches the step of providing an input device comprising providing an input device configured to enter an execute command which initiates a record retrieval from local and remote information sources comprising at least one of a file (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67), a database (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67), a database program, a

computer network, and a contact management program, using the record retrieval program (Abstract; col 3, lines 1-67; col 4, lines 48-67; col 6, lines 1-67).

Allowable Subject Matter

5. Claims 2,9-12,19,23,26 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art of records Williams, Jr. (U.S. Patent No. 6,108,686 and Williams hereinafter) and Halim et al. (U.S. Patent No. 6,304,881 and Halim hereinafter) do not disclose, teach or suggest the claimed limitations of (in combination with all other features in the claims) a method for

storing the first information in the local information source if no second information associated with the first information is found in the local and remote information sources during said searching and wherein displaying step, includes, marking the second information found in the local information source as consistent with the second information found in the remote information source, if second information associated with the first information is found in both the local and remote information sources, marking the second information found in the local information source as inconsistent with the second information found in the remote information source, if

second information associated with the first information is found in only the local and information source, and displaying the marked second information in said record retrieval as claimed in claims 2,19,23,26 and 28

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-79 of U.S. Patent No. 6,323,853 (Hedloy). Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Hedloy (U.S. Patent No. 6,323,853) in claim 1 states a "document" as a "local information source" (as called in the application) and an "information source" as a "remote information source" (as called in the application).

Hedloy (U.S. Patent No. 6,323,853) in claims 1 and 2 states storing the first information and displaying second information and also displaying the similarities and

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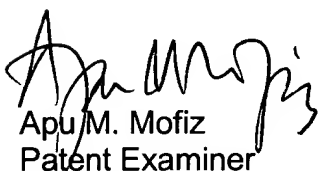
differences between the first and second information. Hedloy in the application stores the first information and displays the similarities and differences (i.e. inconsistencies) by marking the second information.

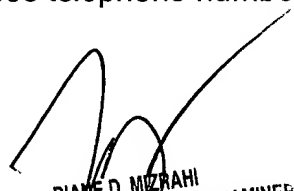
Points of Contact

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Apu M. Mofiz whose telephone number is (703) 605-4240. The examiner can normally be reached on Monday – Thursday 8:00 A.M. to 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached at (703) 3053830. The fax numbers for the group is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.


Apu M. Mofiz
Patent Examiner
Art Unit 2175


DIANE D. MIZRAHI
PRIMARY PATENT EXAMINER
TECHNOLOGY CENTER 2100

September 09, 2002